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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,711	08/13/2001	Samuel Sergio Tenenbaum		6748

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EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/928,711

Applicant(s)

TENEMBAUM

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This Office Action is in response to the patent application number 09/928,711 filed August 13, 2001.

### **Priority**

2. The present patent application claims the benefit of US Provisional Application number 60/229,145, filed August 31, 2000.

### **Status of the claims**

3. The pending claims 1-5 are examined as follows.

### **Claim Objections**

4. Claims 1-5 are objected to because of the following informalities: claim 1 recites the limitation "Author" in line 5, this limitation should be replaced by -author-- (without capitalized A). Appropriate correction is required.

Claims 2-5 are objected to because of the following informalities: "the method of claim1." should be replaced by --the method of claim 1-- (with no period). Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim 1 recites the limitation "the Author" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the reader" in line 1. Although readers (plural) recited in claim 1, but not "reader" (singular). There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the D-Book website" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 contains the trademark/trade name [Shohekele<sup>TM</sup> (spelling error)] Shoshkele<sup>TM</sup> in line 3. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe ad format (Shoshkele<sup>TM</sup>) and, accordingly, the identification/description is indefinite.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner et al, " From Documents to Discourse: Shifting Conceptions of Scholarly Publishing," CHI 98 18-23 April 1998.

Sumner et al (hereinafter "Sumner") is directed to examining and designing new forms of document interface that can be used to support new forms of scholarly discussion and publishing. To accomplish the above tasks Sumner discloses a Digital Document Discourse Environment (D3E) project.

**With regard to claim 1:**

Sumner discloses creating an online e-journal that enables readers to participate in an interactive discussion by posting their comments, as a form of interaction with other readers, reviewers, or author (pages 95, 97, 99, Fig. 5). Sumner meets the limitations of claim 1 except that it employs an electronic journal (e-journal) rather than a dialog book (D-Book) in engaging online discussion. However, because these two documents (e-journal and d-book) were art-recognized equivalents at the time of the invention in those

electronic documents, one of ordinary skill would have found it obvious to substitute a d-book for the e-journal of Sumner.

**With regard to claim 5:**

Sumner also discloses that e-journal features includes internal link, such as link to sections of the e-journal, and external link, such as a link to other e-journal related websites (see pages 98, 100, and Fig. 3, see the description of the drawing).

7. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner et al as applied to claim 1 above, and further in view of McCurdy et al (US 2002/0035697 A1).

**With regard to claim 2:**

While Sumner discloses that the JIME (e-journal) is available free of charge (page 99), but Sumner does not explicitly disclose promoting ("thanks") advertising Shoshkele TM ads on the e-journal (D-book).

McCurdy is directed to systems and methods for distributing and viewing e-documents. In regard to the subject matter of claim 2, McCurdy discloses User interactions to support electronic commerce in digital magazines and catalogs [0025], [0159] and the user is free to view the log of magazine usage data [0116]. McCurdy further discloses promoting animation graphics ads ("Shoshkele") (fig. 3, #92) on the e-document (see paragraph [0223], 0323)).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to provide and expose the e-journal readers of Sumner

with ads of McCurdy in order to provide means to freely operate e-journal discussion/publishing website.

**With regard to claim 3:**

Sumner in view of McCurdy further discloses ad exposure to readers of publications so that readers/user will use the electronic document site for free (see McCurdy, paragraph [0159], [0223]-0224] and [0322]).

**With regard to claim 4:**

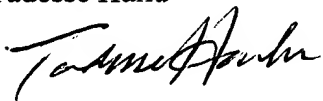
Sumner in view of McCurdy further discloses Subscription management, including payment to access e-publishing website (#50) (see McCurdy, paragraph [0035] and [0187]).

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 6:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu



March 18, 2004